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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/614,649 | 07/07/2003 | Joanne R. Bonnell | 2002P20262 US01 | 7643 |

7590 10/18/2005

Alexander J. Burke
Intellectual Property Department
5th Floor
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

KRAMER, JAMES A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,649

Applicant(s)

BONNELL, JOANNE R.

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

E-A

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's disclosure.

Examiner points out that Applicant's claims are drawn to an apparatus or system. As such, it is the Examiner's duty to focus on the structure of the claims and not the function. See MPEP 2114, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function . . . Apparatus claims cover what a device is, not what a device does". Also, "A claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations."

Based on Applicant's own admission submitted with the Affidavit on 7/25/05, the apparatus of Applicant's invention is old and well known in the retail business chain. For example Exhibit B, page 1 states, "For a healthcare facility, these department keys on the cash register can be programmed to display hospital income categories . . ." Examiner notes that this

Art Unit: 3627

is the same type of modification made for the register between Macy's and K-mart (i.e. customizing the keys on the register).

Further on page 2, paragraph 2, "Internally, the retail store and the healthcare organization must also financially account for all their daily income by appropriately journalizing these transaction. This can be achieved by making programming changes to the electronic cash register for the healthcare facility. A retail store has inventory numbers coded into the register that identifies and accounts for items being purchased. The idea would be to program the cash register to replace the inventory numbers with the healthcare facility's general ledger account numbers so that the total amount of cash received from a particular payer (department key) can be tracked." Examiner once again notes that Applicant is not creating a new structural invention.

Based on Applicant's own admission, the structure of the present invention is old and well known in the retail industry. Further, Applicant appears to describe a new use for said old and well-known structure. As such Examiner notes that the proper statutory class for this invention would be a process or method, which includes a new use of a known machine (apparatus) (see MPEP 706.03(a)). Therefore, Examiner recommends shifting this invention from an apparatus to a method/process.

In light of the general policy of the Office not to permit the Applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter (see MPEP 819); Examiner wishes to notify Applicant that such a switch will be permitted in this case due to the unique circumstances associated with the business methods arts. However, the Office Action following this switch will be properly made final as a result of the amendment.

Art Unit: 3627

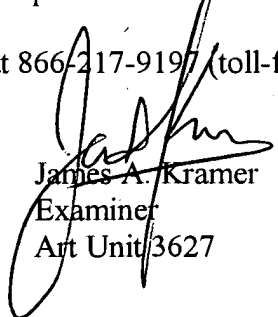
Response to Arguments

Applicant's arguments, see Amendment, filed 8/2/05, with respect to the rejection(s) of claim(s) 1-30 under 35 USC 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in this Office Action (see above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James A. Kramer
Examiner
Art Unit 3627

18/14/05

jak